

REMARKS

Claims 1 and 7-10 and 13-18 appear in this application for the Examiner's review and consideration.

Claim 1 has been amended to include the recitations of dependent claim 7 including the thickness of the thin dense layer. Claim 10 has been amended to add a similar recitation from dependent claim 16. Support for the claim amendments may be found at least in the specification at page 11, lines 11-14 and claims 7 and 16. Claims 7 and 16 have been amended to recite that the thin dense layer does not appreciably affect the overall ball properties of feel, compression and cover hardness. Support for the claim amendments may be found at least in the specification at page 12, lines 1-5. Claims 8 and 9 have been amended to change their dependencies to independent claim 1, and claims 17 and 18 have been amended to change their dependencies to independent claim 10. No new matter has been added by these amendments.

Rejection Over U.S. Patent No. 5,952,415

Claims 1, 7-10 and 13-18 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,952,415 to Hwang *et al.* ("Hwang"). Hwang is generally directed to a golf ball which has good spin property and long carry.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Contrary to the Examiner's assertion, the cited reference does not disclose or suggest the thin dense layer or the thickness of the thin dense layer as now recited in independent claims 1 and 10. No thickness of the layers in Example 5, or any of the other Examples, is less than 1.25 mm. Additionally, the inner cover and middle cover layers in Example 5 of Hwang have the same thickness. Thus, there is no thin dense layer in any of the Examples of Hwang. Hwang simply does not disclose or suggest a thin dense layer of the thickness from about 0.25 mm to about 0.5 mm as recited in amended independent claims 1 and 10.

The Examiner stated in the Office Action that Applicant does not set forth any advantages of having a thickness of about 0.25 to 0.5 mm and the distinctions between the dimensions of the layer appear to be mere obvious design choices. Applicant disagrees.

As discussed in the specification, the thin high gravity layer 24 results in a ball that has a “high moment of rotational inertia and low initial spin rates to reduce slicing and hooking when hit with a driver club . . .” (Specification, page 6, lines 20-24; page 11, lines 11-25). Moreover, the requirement that the layer be thin, and most preferably from about 0.25 mm to 0.5 mm, ensures that except for the moment of inertia and CoR, the presence of the thin dense layer preferably does not appreciably affect the overall ball properties, such as the feel, compression, and cover hardness.” (Specification, page 11, lines 11-14 and page 12, lines 1-5). There is no suggestion in Hwang to make the middle cover thin, such that the layer will not appreciably affect the overall ball properties. Specifically, the inner cover and middle cover layers of Example 5 in Hwang have the same thickness and are made of almost the exact same formulation, so each layer should equally affect the ball properties. Additionally, there is no teaching or suggestion to make this middle cover layer dense, such that more weight is moved to the outer portion of the golf ball to affect the moment of inertia or CoR of the golf ball. Hwang simply does not teach or suggest having a thin dense layer of the claimed thickness.

Thus, amended independent claims 1 and 10 are patentable over the cited art. As such, dependent claims 7-9, which depend from independent claim 1, and dependent claims 13-18, which depend from independent claim 10, should be patentable for at least the same reasons set forth above. Additionally, the Examiner states that Hwang discloses the same structure and composition and that it inherently meets the specific gravity claimed in claims 8, 9, 17 and 18. Applicant disagrees. Hwang does not disclose a middle cover layer having the claimed thickness and the claimed specific gravity.

The rejections under 35 U.S.C. § 103(a) are believed to have been overcome for at least the above reasons. Applicant respectfully requests reconsideration and withdrawal thereof.

Conclusion

Based on the remarks set forth above, Applicant believes that all of the rejections have been overcome and the claims of the subject application are in condition for allowance. Should the Examiner have any further concerns or believe that a discussion with the Applicant’s attorney

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would further the prosecution of this application, the Examiner is encouraged to call the attorney at the number below.

No fee is believed to be due for this submission. However, should any required fees be due, please charge them to Acushnet Company Deposit Account No. 502309.

Respectfully submitted,

3 Aug 05
Date


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Attachments